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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,021	09/05/2003	Makarand P. Gore	200312226-1	8140

22879 7590 05/06/2005

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EXAMINER	
LE, HOA VAN	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,021	GORE, MAKARAND P.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-19* is/are pending in the application.

4a) Of the above claim(s) *6-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-5 and (17-19 for the record)* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *2-19* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)

This is in response to Papers filed on 13 April 2005.

I. Applicant elects the invention of claims 1-5 (now 2-5) being acknowledged. Applicant urges that the invention of claims 17-19 is so related to claim 2. It is reasonable. Therefore, the related claims 17-19 as urged will be allowed to be rejoined with claim 2 when it is found to be allowable.

II. Applicant prior art submission filed on 28 January 2005 has been considered to the extent of the English language being provide. JP '838 and DE '738 are not considered because there is no English language of a pertinent portion being provided. EP '336, EP '343 and EP '353 are not considered because no copy is provided.

III. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 4-5 and (17-19 for the record) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-7, 36 and 40-42 (allowed on 12 April 2005) of copending Application No. 10/351,188. Although

the conflicting claims are not identical, they are not patentably distinct from each other because the specific phthalocyanine and naphthalocyanine chromophore antennas in the instant claims are not patentably distinct from the phthalocyanine and naphathalocyanine dye antennas (being specified as "a radiation absorbing compound such as a dye" in the specification on page 4, line 4 in application Serial No. 10/351,188) as those in the applied claim 5.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

IV. Claim 3 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 36 and 40 of copending Application No. 10/315,188 in view of Azuma (6,815,679).

The applied claims are related to a direct light image composition comprising a matrix, an antenna, color former and an activator. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix.

The applied claims do not include "silicone 2,3 naphthalocyanine bis(trihexalsilyoxide)" as that in the instant claim 3. Azuma at col.18:55-56 is cited to show the known use of silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) as a radiation absorbing compound as that in the instant claim.

Since the above references are all related to the selection and use of radiation absorbing compounds, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to known silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) for a reasonable expectation of absorbing radiation energy as disclosed and taught in Azuma.

This is a provisional obviousness-type double patenting rejection.

V. Claim 3 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 36 and 40 of copending Application No. 10/315,188 in view of Jones et al (6,682,810).

The applied claims are related to a direct light image composition comprising a matrix, an antenna, color former and an activator. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix.

The applied claims do not include "silicone 2,3 naphthalocyanine bis(trihexalsilyoxide)" as that in the instant claim 3. Jones et al at col.8:23-24 is cited to show the known use of silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) as a radiation absorbing compound as that in the instant claim.

Since the above references are all related to the selection and use of radiation absorbing compounds, it would have been obvious to one having ordinary skill in the art at the time the invention was made to known silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) for a reasonable expectation of absorbing radiation energy as disclosed and taught in Jones et al.

This is a provisional obviousness-type double patenting rejection.

VI. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 4-5 and (17-19 for the record) are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by Gore et al (Application Serial No. 10/351,188).

Gore et al disclose and teach a direct light image composition comprising a matrix, an antenna, color former and an activator. The chemical ingredients are read on those in the instant claims. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix. The antenna has the property of absorbing laser and infrared radiations. Please see the whole disclosure of the applied application, especially at claims 1, 5-7, 36 and 40-42.

Since Gore et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Gore et al.

VII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al (Application Serial No. 10/351,188) considered in view of Azuma (6,815,679).

Gore et al disclose, teach and suggest a direct light image composition comprising a matrix, an antenna, color former and an activator. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix. The antenna has the property of absorbing laser and infrared radiations. Please see the whole disclosure of the applied application, especially at claims 1, 5-7, 36 and 40-42.

Gore et al do not include "silicone 2,3 naphthalocyanine bis(trihexalsilyoxide)" as that in the instant claim 3. Azuma at col.18:55-56 is cited to show the known use of silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) as a radiation absorbing compound as that in the instant claim.

Since the above references are all related to the selection and use of radiation absorbing compounds, it would have been obvious to one having ordinary skill in the art at the time the invention was made to known silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) for a reasonable expectation of absorbing radiation energy as disclosed and taught in Azuma.

VIII. Claim 3 is provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al (Application Serial No. 10/351,188) considered in view of Jones et al (6,682,810).

Gore et al disclose, teach and suggest a direct light image composition comprising a matrix, an antenna, color former and an activator. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix. The antenna has the property of absorbing laser and infrared radiations. Please see the whole disclosure of the applied application, especially at claims 1, 5-7, 36 and 40-42.

Gore et al do not include "silicone 2,3 naphthalocyanine bis(trihexalsilyoxide)" as that in the instant claim 3. Jones et al at col.8:23-24 is cited to show the known use of silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) as a radiation absorbing compound as that in the instant claim.

Since the above references are all related to the selection and use of radiation absorbing compounds, it would have been obvious to one having ordinary skill in the art at the time the invention was made to known silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) for a reasonable expectation of absorbing radiation energy as disclosed and taught in Jones et al.

IX. Applicant's arguments filed 13 April 2005 have been fully considered. Applicant states that a terminal disclaimer will be filed.

X. The non-elected inventions of claims 6-16 are permitted to be rejoined with claims 2-5 when claims 2-5 are allowable provided that claims 6-16 must contain all of the limitations of at

least claim 2. Accordingly, it is permitted to amend claims 6-16 to include all of the limitations of at least claim 2.

XI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
03 May 2005

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le